

Application No. 10/616,005
Amendment to Office Action of 2/9/2007

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I. SPECIFICATION

A. The objection to the specification should be withdrawn because the incorporated material has been inserted via this Amendment and is now clearly identified.

Applicant has amended the specification via this Amendment to include the patent application number of a related concurrently filed patent application. Applicant respectfully requests the withdrawal of this objection.

B. The objection to the specification should be withdrawn because the URL stated in the specification is not an incorporation by reference, but merely an example URL that is permitted by MPEP § 608.01.

Applicant respectfully traverses the Examiner's objection to the specification regarding the example "embedded hyperlink" found on page 2, line 16. The following is a quotation of the relevant paragraph in MPEP § 608.01 concerning hyperlinks:

The attempt to incorporate subject matter into the patent application by reference to a hyperlink and/or other forms of browser-executable code is considered to be an improper incorporation by reference. See >37 CFR 1.57(d) and < MPEP § 608.01(p), paragraph I regarding incorporation by reference. Where the hyperlinks and/or other forms of browser-executable codes themselves rather than the contents of the site to which the hyperlinks are directed are part of applicant's invention and it is necessary to have them included in the patent application in order to comply with the requirements of 35 U.S.C. 112, first paragraph, and applicant does not intend to have these hyperlinks be active links, examiners should not object to these hyperlinks. The Office will disable these hyperlinks when preparing the text to be loaded onto the USPTO web database. (emphasis added)

The specification on page 2 with the example URL states:

A browser is able to access a web site on the Internet through the use of a URL. The URL may include a Hypertext Transfer Protocol (HTTP) request combined with the web site's internet address, also known as the web site's domain name. An example of a URL with a HTTP request and domain name is:

<http://www.companyname.com>

In this example, the "http" identifies the URL as a HTTP request and the "www.companyname.com" is the domain name.

The URL in question is not attempting "to incorporate subject matter into the patent application by reference to a hyperlink" nor is it intended to be an active link. The content of any Web site at the example URL, assuming there even is an active Web site there, is not incorporated into nor part of the disclosure for this invention. The example URL is merely being used to explain "part

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of applicant's invention" (as permitted by MPEP § 608.01) and thus Applicant respectfully requests the withdrawal of this objection.

II. CLAIM OBJECTION

The OA on page 3 objected to claims 8 and 9 on the grounds that the claims are system claims that depend on a manufacture claim. Claims 8 and 9 are being amended via this Amendment in a manner which Applicant believes moots this objection. Thus, Applicant respectfully requests the withdrawal of this rejection.

III. CLAIM REJECTION – 35 USC § 101

The OA on page 4 states "Claims 1-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter." Applicant has amended the preambles of independent claims 1 and 6 to clarify that the reseller program utilizes a computer network and are thus directed towards statutory subject matter. With the amendments to claims 1 and 6 (and thus their dependent claims 2-5 and 7-9), Applicants respectfully request the withdrawal of this rejection.

IV. DOUBLE PATENTING

The OA on page 5 states:

Claim 6 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 6 of copending Application No. 10/616,195. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

As to claim 6, Maxson teaches the same invention as in claim 6 of copending Application No. 10/616,195.

The relevant section in the MPEP related to statutory double patenting is as follows:

MPEP 804 II A. Statutory Double Patenting - 35 U.S.C. 101

In determining whether a statutory basis for a double patenting rejection exists, the question to be asked is: Is the same invention being claimed twice? 35 U.S.C. 101 prevents two patents from issuing on the same invention. "Same invention" means identical subject matter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1984); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957).

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A reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). Is there an embodiment of the invention that falls within the scope of one claim, but not the other? If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting would not exist. For example, the invention defined by a claim reciting a compound having a "halogen" substituent is not identical to or substantively the same as a claim reciting the same compound except having a "chlorine" substituent in place of the halogen because "halogen" is broader than "chlorine." On the other hand, claims may be differently worded and still define the same invention. Thus, a claim reciting a widget having a length of "36 inches" defines the same invention as a claim reciting the same widget having a length of "3 feet."

Original claim 6 (please note that the amendments to claim 6 made in this Amendment are not shown below so as to not confuse the current issue) from the current application (App. No. 10/616,005) is:

6. A reseller program for allowing a plurality of Customers to register one or more domain names via a Registrar, comprising:
 - A) a registrar web site adapted for receiving information from a reseller web site and registering domain names with an appropriate Registry; and
 - B) an administration web site adapted for allowing Resellers to enter the reseller program and allowing each Reseller to customize the registrar web site for their own Customers.

Original claim 6 (which has since been amended during its prosecution in a different Amendment) from App. No. 10/616,195 is:

6. A reseller program for allowing a plurality of Customers to register one or more domain names via a Registrar, comprising:
 - A) a registrar web site adapted for receiving selected domain names from a plurality of Customers and for registering the selected domain names with an appropriate Registry; and
 - B) an administration web site adapted for allowing Resellers to enter the reseller program and allowing each Reseller to customize the registrar web site for their Customers.

Applicant respectfully submits that the same invention is not being claimed twice because receiving "selected domain names from a plurality of Customers" (from claim 6 in

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Application No. 10/616,195) has a different claim scope than receiving “information from a reseller web site” (from claim 6 in Application No. 10/616,005). Specifically, not only is the type of data received different, (“selected domain names” vs. “information”), but the source of the data is also different (“plurality of Customers” vs “a reseller web site”). Applicant respectfully requests the withdrawal of this objection.

V. CLAIM REJECTIONS – 35 USC § 102 FOR CLAIMS 1-17 SHOULD BE WITHDRAWN BECAUSE NOT EVERY ELEMENT IS TAUGHT

Claims 1-17 stand rejected under 35 U.S.C. 102(e) as being unpatentable over Bayles (U.S. Patent No. 7,039,697). Applicant respectfully traverses this rejection.

MPEP 2143.03 All Claim Limitations Must Be Taught or Suggested

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

A. The rejection should be withdrawn for claims 1 (and thus dependent claims 2-5) and 10 (and thus dependent claims 11-13). Bayles teaches providing services via “a business employing the present invention. Bayles does not teach the limitation of allowing reseller web sites to register domain names via a registrar web site. Bayles disclosure makes it clear that “a business employing the present invention” cannot be the claimed “registrar web site” for reasons fully explained below.

The OA on pages 6 and 7 states that Bayles teaches limitation C) of claims 1 and 10:

C) means for allowing a plurality of reseller web sites to register one or more domain names for one or more customers via the registrar web site (column 6, lines 26-28)

The section in Bayles (column 6, lines 26-28) that the OA relies upon to disclose this limitation states:

Primary customers of a business employing the present invention would be domain name registrars and resellers (such as in a thick registry system).

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This comparison of limitation C) in claims 1 and 10 with the section cited in Bayles, as proposed by the OA, has a serious defect. The “registrar web site” in claims 1 and 10 performs the function of registering domain names for reseller web sites. The “business employing the present invention” from Bayles also performs a type of domain name registration service for resellers (and domain name registrars). Thus, for the analogy proposed by the OA to be valid, the “registrar web site” (from claims 1 and 10) must correspond, and teach, the “business employing the present invention” (from Bayles). However, for three different reasons explained below, the “business employing the present invention” (from Bayles) teaches away from the limitation “registrar web site” (from claims 1 and 10). Thus, Bayles does not teach at least limitation C) of claims 1 and 10.

The first reason that Bayles does not disclose limitation C) is that the sentence in Bayles cited by the OA states that the “[p]rimary customers of a business employing the present invention would be domain name registrars and resellers.” Substituting the “registrar web site” for “a business employing the present invention”, as implied by the OA as teaching the same thing, results in the sentence of the “[p]rimary customers of a ‘registrar web site’ would be domain name registrars and resellers.” Clearly, registrars are not the primary customers of a registrar (or a “registrar web site”). Thus, for at least this reason, Bayles does not teach limitation C).

The second reason that Bayles does not disclose limitation C) is that the “business employing the present invention” is described in Bayles (column 5, lines 38-41) as:

The services are actually provided by a single (i.e. only one is permitted per registry) intermediary entity or software routine implemented at the registry.

Since Bayles teaches that the services are provided by a “single” intermediary entity per registry (or software routine implemented at the registry), it is clear that the “business employing the present invention” in Bayles cannot be the claimed “registrar web site” because those of ordinary skill in the art at the time of the invention would know that there may be a plurality of registrars (and thus registrar web sites) per registry. Because Bayles’ “business employing the present invention” (where only a single one per registry may exist) cannot be “a registrar web site” (where a plurality per registry may exist), Bayles does not teach the limitation C) of claims 1 and 10 as stated in the OA.

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The third reason that Bayles does not disclose limitation C) is that by combining the result from the first reason, i.e. that a registrar would have to be the primary customer of a registrar, with the result from the second reason, i.e. that only a single entity per registry may exist, results in the very strange result that a registrar would have to be its own “primary customer.” At least for these three reasons, Bayles does not disclose limitation C) of claims 1 and 10. Thus, Applicant respectfully requests the allowance of claims 1 and 10 and their corresponding dependent claims 2-5 and 9-13.

If the Examiner was not trying to use Bayles’ “business employing the present invention” to teach the limitation “the registrar web site”, then Applicant respectfully submits that Bayles teaches away from claims 1 and 10. Claims 1 and 10 include the limitation of domain names being registered “via the registrar web site” while Bayles teaches its domain name services are performed by the “business employing the present invention.” Thus, if the Examiner is not using Bayles’ “business employing the present invention” to teach the claimed “registrar web site”, then Bayles’ method of registering domain names via a “business employing the present invention” teaches away from the method of registering domain names “via a registrar web site” as found in claims 1 and 10.

B. The rejection should be withdrawn for claims 6 (and thus claims 7-9) and 14 (and thus claims 15-20). The OA does not point out where in Bayles that claims 6 and 14 are taught.

Applicant was unable to find in the OA where the Examiner pointed out in Bayles where the limitations of claims 6 and 14 are taught. Thus, Applicant respectfully requests the withdrawal of this rejection and the allowance of claims 6-10 and 14-20.

VI. CLAIM REJECTIONS – 35 USC § 103 FOR CLAIMS 18 & 19 SHOULD BE WITHDRAWN

Claims 18 and 19 stand rejected un 35 U.S.C. 103(a) as being unpatentable over Bayles in view of Vaidyanathan. Applicant respectfully traverses this rejection.

The OA on page 8 states:

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As to claim 18, Bayles teaches the reseller program of claim 14.

The OA on page 9 states:

As to claim 19, Bayles teaches the reseller program of claim 14.

Applicant respectfully submits that the OA does not point out where in Bayles that the limitations of claim 14 are taught. Thus, Applicant respectfully requests the withdrawal of this rejection and the allowance of claims 18 and 19.

In addition, Applicant respectfully traverses the combination of Bayles with Vaidyanathan. Bayles teaches a method of integrating a domain name monitoring and acquisition service with a registry (see abstract). Vaidyanathan teaches a method of making a digital file marketplace accessible by consumers (see abstract). Thus, Bayles and Vaidyanathan are trying to solve very different problems. Nevertheless, the OA takes portions of Vaidyanathan related to its Marketplace 10 (which the OA appears to compare with the claimed “administration web site”) and combines it with the teachings of Bayles. Applicant respectfully submits that there is not a reasonable expectation of success in the combination of Bayles and Vaidyanathan.

VII. NEWLY ADDED CLAIM 20

Newly added claim 20 is submitted to provide Applicant the scope of protection to which Applicant are believed to be entitled. The claim differs from the prior art at least by virtue of its dependence on claim 14 which is believed to be allowable as previously stated. No new matter is introduced and early examination and allowance of all pending claims is respectfully requested.

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CONCLUSION

Applicant respectfully submits that not all of the claim limitations are taught by Bayles and Vaidyanathan for claims 1-20 as explained above. Applicant thus requests the allowance of all pending claims, i.e. claims 1-20, as soon as possible. Any questions or suggestions regarding this Amendment should be directed to the undersigned attorneys for Applicants at the telephone number or email address listed below.

Respectfully submitted,

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Date: 5/9/2007

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